

Remarks

Applicant's claim 1 recites a "shank having sufficient length such that said proximal end rests in the palm of the physician's hand" With regard to the rejection of claims 1-3 under 35 U.S.C. § 103(a) based on Shubert (U.S. 2,811,969) in view of Cotey (U.S. 3,749,099), the Examiner argued that "[i]t would have been obvious to form the proximal end of the device of Shubert to rest in the palm of a physician's hand, since nothing prevents the device from doing so based upon the length of the shank and the physician's hand." *See* Office Action at 3. However, Applicant respectfully draws the Examiner's attention to the fact that the proximal end 34 of the Shubert device includes a direction indicating element 36 that is disposed on the flexible rod 28 in the same direction as is the cutter element 30 to indicate the general direction of the cutting teeth 32 when the body portion 16 is inserted into a position adjacent the amniotic sac. *See* Shubert, col. 2, lines 27-36 and Figs. 1-3. In order for Shubert's direction indicating element 36 to serve its intended purpose, the proximal end 34 must extend past the physician's hand externally of the vagina into which the physician's finger has been inserted. *See* Shubert, col. 2, lines 63-67 and Figs. 2-3. If the Shubert device were modified such that the proximal end 34 thereof rested in the palm of the physician's hand as the Examiner has proposed, such modification would defeat the intended purpose of the direction indicating element 36 by rendering it unviewable. When modification of a reference in a proposed manner would defeat its intended purpose, the reference actually teaches away from the proposed modification and fails to establish a prima facie case of obviousness. *See In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Therefore, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness, and Applicant's claims 1-3 are allowable over the art of record.

Applicant has added new claims 4-20 variously claiming allowable subject matter disclosed in the specification. Support for the claimed features is found in the specification as follows:

Claim 4: acute angle, see p. 10, lines 20-21 and Fig. 4A;

Claim 5: cutting edge sharper than point, see p. 10, line 23 to p. 11, line 1;

Claim 6: point flared slightly out of recess, see p. 14, lines 2-4;

Claim 7: recess comprises opening through distal end, see p. 13, lines 20-21 and Figs. 5A, 5B;

Claim 8: shank relatively flat and thin, see p. 8, line 21 and Figs. 2A-2C, 3A, 3B;

Claim 9: flared base handle, see p. 9, lines 7-12 and Figs. 1, 2C, 3B;

Claim 10: at least one ridge, see p. 9, lines 12-14 and Figs. 2A-2C, 3A, 3B;

Claim 11: shank has arcuate shape in unflexed state, see p. 8, lines 10-13 and Figs. 1, 2A;

Claim 12: at least a portion of a glove attached to shank, see p. 14, lines 18-19; p. 15, lines 6-9; and Fig. 6;

Claim 13: opening allowing physician to feel anatomical structures, see p. 11, lines 4-20; other features, see specification references above;

Claim 14: oval shaped opening, see p. 11, line 6 and Figs. 1, 2C, 3B, 6;

Claim 15: at least one ridge, see p. 9, lines 12-14 and Figs. 2A-2C, 3A, 3B;

Claim 16: glove-like member and fingertip member, see p. 14, lines 9-23 and Fig. 6;

Claim 17: point formed at tip of hook having shielded cutting edge, see p. 10, line 7 to p. 11, line 3; Figs. 4A-5B; and claim 2;

Claim 18: leading edge of hook substantially flush with surface of fingertip member and hook positioned in recess, see p. 13, lines 16-23; Figs. 5A-5B; and claim 3;

Claim 19: point flared slightly out of recess, see p. 14, lines 2-4;

Claim 20: opening allowing physician to feel anatomical structures, see p. 11, lines 4-20.

Applicant submits the enclosed substitute Sheets 3 and 5 of the drawings in order to bring the drawings into agreement with the specification. Specifically, Figs. 3B and 5B have been amended to include reference numbers 48a and 48b as described in the specification at page 14, line 3. Figs. 3A and 5A remain unchanged.

The above amendments involve no new matter.

In view of the foregoing, Applicant respectfully submits that claims 1-20 are allowable over the art of record and requests that a timely Notice of Allowance be issued in this application. If the Examiner believes that a telephone conference would advance the prosecution of this application, the Examiner is respectfully requested to contact the undersigned attorney.

It is believed that no fee is required for this submission. However, if any fee is required, the Commissioner is hereby authorized to charge any required fee to Deposit Account No. 502248.

Respectfully submitted,

Court B Allen

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